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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Intermedia Advertising Group, Inc.

Serial No. 76092228

Francie R. Gorowitz of O'Melveny & Myers LLP for Intermedia Advertising Group, Inc.

Idi Aisha Clarke, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney).

Before Quinn, Hohein and Hairston, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Intermedia Advertising Group, Inc. has filed an application to register the mark "REWARDTV" for "business marketing and consulting services; conducting business research and surveys, promoting the sale of goods and services of others through promotional contests on the Internet; and providing a website which features advertisements for the goods and services of others on the Internet" in International Class 35 and "entertainment services, namely, providing an on-line computer

game; [and] entertainment services, namely, providing information on-line about television programs" in International Class 41.¹

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that, when used in connection with applicant's services, the mark "REWARDTV" is merely descriptive of them.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We reverse the refusal to register.

It is well settled that a mark is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a mark describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the mark describes a significant attribute or idea about them. Moreover, whether a mark is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used or

¹ Ser. No. 76092228, filed on July 19, 2000, based upon an allegation of a bona fide intention to use such term in commerce and subsequently amended to allege, as to the services in both classes, a date of first use anywhere and in commerce of August 1, 2001.

is intended to be used on or in connection with those goods or services and the possible significance that the mark would have to the average purchaser of the goods or services because of the manner of such use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

However, a mark is suggestive if, when the goods or services are encountered under the mark, a multi-stage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See, e.g., *In re Abcor Development Corp.*, supra at 218, and *In re Mayer-Beaton Corp.*, 223 USPQ 1347, 1349 (TTAB 1984). As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. See, e.g., *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992) and *In re TMS Corp. of the Americas*, 200 USPQ 57, 58 (TTAB 1978). The distinction, furthermore, is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. See *In re George Weston Ltd.*, 228 USPQ 57, 58 (TTAB 1985).

Applicant, in its response to the mere descriptiveness refusal raised in the initial Office action, has acknowledged that its "services include the hosting of an entertainment based

web-site" and that "some of the content of the web-site may relate to television ... and to games and promotions, which may result in the granting of rewards, possibly rendering the individual words [REWARDS and TV] descriptive of features of the services." Applicant maintains, however, that the combination of such words "creates a compound term which is not merely descriptive" because, contrary to the Examining Attorney's contention, its "services do not consist of providing television related awards." In particular, as applicant further explains by way background in its main brief:

Applicant conducts marketing and advertising services through a website that provides an on-line computer game. To play the game, consumers are required to watch specific television shows and answer a series of questions about the shows. They are awarded points for correct answers. The consumers can then redeem their points by entering sweepstakes to win prizes, which may not be related to TV, e.g. payment of an exorbitant phone bill, tickets to movie theaters, and gift cards for department stores. On the website, Applicant advertises its clients' products, which may also be awarded as prizes and offers to send further information about such products to the consumers.

In view thereof, and while relying principally on a case which is not citable precedent,² applicant argues in its main brief that it "has created a word combination that is not recognizable as describing a particular characteristic of Applicant's services" inasmuch as "[t]here is no such thing as a 'rewardtv' nor is there any action that can be termed a

² In re In re On Technology Corp., 41 USPQ2d 1475 (TTAB 1996), which is designated as an "Unpublished" decision and thus "is not citable as precedent of the TTAB."

'rewardtv.'" Applicant therefore maintains that the mark "REWARDTV" is suggestive rather than merely descriptive of its services because "imagination, thought or perception is required to reach a conclusion about Applicant's services." Any doubt in this regard, applicant adds, should be resolved in its behalf and its mark should be published for opposition in accordance with the Board's established practice.³

The Examining Attorney, on the other hand, asserts that "no amount of imagination, thought or perception is required to determine the nature of the services" because "[t]he words REWARD and TV refer to rewards or prizes given to those who watch TV." In consequence thereof, the Examining Attorney insists that the mark "REWARDTV" is merely descriptive of applicant's services because, when used in connection therewith, the mark "conveys to consumers that the applicant offers recompense in the form of merchandise to people who watch particular television programs."

In support thereof, the Examining Attorney cites the definitions of the following words which are of record from The American Heritage Dictionary of the English Language (3rd ed. 1992): (i) "reward," which is defined in relevant part as "1. Something given or received in recompense for worthy behavior"; (ii) "TV," which is set forth as denoting "Television"; and (iii) "television," which is listed as variously meaning "1. The transmission of visual images of moving and stationary objects, generally with accompanying sound, as electromagnetic

³ See, e.g., *In re Conductive Systems, Inc.*, 220 USPQ 84, 86 (TTAB 1983); *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981); and *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).

waves and the reconversion of receive waves into visual images.

2. a. An electronic apparatus that receives electromagnetic waves and displays the reconverted images on a screen. **b.** The integrated audible and visual content of the electromagnetic waves received and converted by such an apparatus. **3.** The industry of producing and broadcasting television programs." In addition, the Examining Attorney refers to applicant's specimens of use, which are printouts from its website, and argues that "applicant explains the services by using the terms in the mark descriptively."

As examples of the above, the Examining Attorney points to the following excerpts, among others, which appear on the specimens of use for applicant's entertainment services in International Class 41 (bold in original):

"What is RewardTV? It's the FREE TV Trivia site that awards cash & prizes for watching TV!"; and

"The RewardTV Rewards Program (the 'Program') is open to members of RewardTV ... and is subject to the following Rewards Program Rules.

....

How to Play RewardTV Games

....

To play, go to <http://www.rewardtv.com> and sign in using your email address and password. Click on the 'Play' button. Under 'Active Shows,' click on a Primetime Show which you watched during the preceding 19-27 hours, depending on the time zone in which you reside. You will then be asked a series of multiple-choice trivia and survey questions about that Primetime Show and the commercial advertising that aired during its broadcast. Use your mouse to click on the answer you wish to submit. For each

correct answer you submit for a question about a Primetime Show, you will receive 100 TV Points. TV Points will not be deducted for incorrect answers. In order to complete a RewardTV Game, you must answer all questions in sequential order. All submitted answers are final. After you have finished playing, the amount of TV Points you earned will be displayed and automatically credited to your Account.

....
How to Redeem TV Points

....
TV Points in your Account may be redeemed only for available products and/or services ('Rewards') listed in the Rewards Catalog ('Rewards Catalog') on the Site, provided that your Account contains the minimum number of TV Points required for redemption of the requested Reward.
REWARDS ARE AVAILABLE FOR REDEMPTION IN LIMITED QUANTITIES AND ON A FIRST COME, FIRST SERVE BASIS.
REWARDTV IS NOT RESPONSIBLE FOR, AND MAKES NO GUARANTEE ABOUT, THE AVAILABILITY OF ANY REWARD AT ANY GIVEN TIME INCLUDING BUT NOT LIMITED TO REWARDS LISTED IN THE REWARDS CATALOG

....
Reward Fulfillment

All Rewards will be fulfilled within approximately 6-8 weeks from submission of the Redemption Request Form ..., unless otherwise specified in the rules and restrictions listed in the Rewards Catalog for a particular Reward. ANY REWARDS TO BE FULFILLED TO MEMBERS UNDER THE AGE OF 18 MAY BE ... FULFILLED IN THE NAME OF THE MEMBER'S PARENT OR GUARDIAN. REWARDTV DOES NOT GUARANTEE FULFILLMENT WITHIN THE ESTIMATED TIME AND IS NOT LIABLE FOR ANY FAILURE TO FULFILL A REWARD WITHIN THE ESTIMATED TIME.

....
ALL REWARDS ARE PROVIDED SOLELY BY VENDORS. REWARDTV MAKES NO REPRESENTATION OR WARRANTY IN ANY RESPECT IN CONNECTION WITH ANY REWARD. A VENDOR MAY SUBSTITUTE A REWARD WITH A DIFFERENT REWARD OF EQUAL OR GREATER VALUE. REWARDS ARE NOT TRANSFERABLE OR SUBSTITUTABLE FOR CASH OR TV POINTS.

....
Tax Information

All federal, state, local, and other taxes on a Reward are the sole responsibility of the Member who redeems that Reward."

Similarly, the specimens of use for applicant's various business marketing, research, survey, consulting and promotional services, including the providing of an Internet website which features advertisements for goods and services, mention "Our latest winners -- and the cool stuff they got" and list "This Week's Top Rewards" as "Pay My Telephone Bill," "National Amusements/Multiplex Cinemas," "\$50 Wal-Mart® Gift Card," "Canon Hi 8mm Camcorder" and "Olympus Digital Camera." Other excerpts from applicant's website, which were made of record with the final refusal to register, refer to applicant's "RewardTV" services as "the place where you get stuff for watching TV" and "the frequent flyer program for TV lovers." Moreover, as the Examining Attorney points out, a "page of the applicant's website has a section entitled 'REWARDS for watching' where some of the reward links are titled, 'Hollywood Insider,' 'Food Me,' and 'Pay My Bills.'"

With respect to applicant's argument that, even if the terms "REWARD" and "TV" are individually descriptive of its services, the combination thereof into the mark "REWARDTV" is nonetheless suggestive of such services, the Examining Attorney correctly concedes that "a mark which combines descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning," citing *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001). The Examining Attorney contends, however, that in this case "no separate, nondescriptive meaning is formed, arguing that:

No novel spellings or unique juxtapositions are apparent in the mark to support a finding of a nondescriptive or suggestive meaning. The combination of REWARD and TV does not lend itself to any other meaning or significance other than identifying a quality or feature of the services, namely that rewards are given for watching TV.

In order to know who should be given rewards, the applicant must be able to determine who has actually watched the television programs. One way to track viewers is to have them provide answers to questions that only a person who watched the program would know. The fact that the applicant chose a trivia game as a method of identifying viewers does not amount to a series of questions or steps that would invoke imagination, thought or perception in a consumer's mind such that it would make the mark nondescriptive. The mark is not suggestive merely because the trivia game feature of the services is not part of the mark. It is not necessary that a term describe all of the purposes, functions, characteristics or features of the services to be merely descriptive. It is enough if the term describes one attribute of the services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982). Ultimately, the mark REWARDTV describes at least one feature of the applicant's services, namely, that viewers get rewards for watching television.

While we agree with the Examining Attorney that the term "REWARD" describes a significant feature or characteristic of applicant's services in that such term designates any of the prizes and awards which participants in applicant's services are eligible to win if they correctly answer questions concerning television programs they have viewed and that the term "TV" describes the subject matter of such questions, we concur with applicant that the mark "REWARDTV" is suggestive rather than merely descriptive of its services. Literally, none of applicant's services consists of or involves the rewarding of

television or a reward for television, although plainly such services include, as a significant aspect thereof, providing prizes and awards as rewards to viewers of certain television programs who correctly answer trivia questions about the show or shows they have watched. While such rewards clearly appear to be the inducement by which applicant, through the television show trivia game it provides as entertainment services on its website, is able to conduct market research and advertise various goods and services of others, we are constrained to agree with applicant that it requires a multi-step reasoning process, involving thought and perception, to arrive at the Examining Attorney's conclusion that a feature or characteristic of applicant's services which is described by the mark "REWARDTV" is that "viewers get rewards for watching television." Instead, as applicant persuasively emphasizes in its reply brief, it is actually the case that "consumers are required to watch specific television shows and *answer a series of questions* about the shows" (*italics in original*). Strictly speaking, therefore, "consumers are not rewarded for watching television, but rather, they are eligible to be rewarded for proper responses to trivia questions" based on watching such shows. Thus, in order to reach the Examining Attorney's conclusion, a mental process involving imagination, thought and perception is "required to associate Applicant's mark with features of Applicant's services," which is indicative of a suggestive mark instead of one which is merely descriptive.

Stated otherwise, there is just enough ambiguity in the mark "REWARDTV" that it fails to convey forthwith information concerning a significant characteristic or feature of applicant's services. The immediacy required for applicant's mark to be considered merely descriptive of its services is therefore lacking.

Finally, because at the very least we have doubt that applicant's mark would immediately convey a characteristic or feature of its services, we resolve such doubt, in accordance with the Board's settled practice, in favor of the publication of applicant's mark for opposition.

Decision: The refusal under Section 2(e)(1) is reversed.